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JGJR.: 06-05

Paper No: \_\_\_\_

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**JUN 16 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Dygert, et al. :  
Application No. 09/976,038 :  
Filed: 15 October, 2001 :  
Attorney Docket No. 1617.1001CIP :  
(MBHB 03-622A) :

**ON PETITION**

This is a decision on the renewed petition under ¶(a) of 37 C.F.R. §1.47, filed on 11 April, 2005.

The petition is **GRANTED**.

**BACKGROUND**

The record indicates:

- there are three related but certainly separate applications, to wit:
  - the parent 09/227,086 (the '086 application) (filed 5 January, 1999, and issued as Patent No. 6,304,523 on 16 October, 2001 (the '523 patent));
  - the instant application (a continuation-in-part of the parent) 09/976,038 (the '038 application) (filed 15 October, 2001); and

–the re-issue application (of the ‘523 patent) 10/687,510 (filed 16 October, 2003) (the ‘510 application);

- Petitioner Joseph P. Herndon (Reg. No. 50,469) has averred that:

–the instant ‘038 application was filed in error and without deceptive intent (by prior Counsel) with only three co-inventors listed (to wit: Timothy W. Dygert (Mr. Dygert), Sethu K. Madhavan (Mr. Madhavan), and Gerard V. Talatinian (Mr. Talatinian), and an oath/declaration signed by Messrs. Dygert, Madhavan and Talatinian was filed in the application;

–however, Petitioner has come to know that Scott A. Jones (Mr. Jones) and Douglas M. Keenan (Mr. Keenan) also were co-inventors, and to this end Petitioner has sought to obtain the signatures of all five co-inventors on a new oath/declaration and statements from all inventors as to the lack of deceptive intent, and thereby also obtain a correction of inventorship under 37 C.F.R. §1.48 (filed separately and before the Examiner);

- also included with the original petition were

–two pieces of correspondence (dated 28 May, 2004, and 9 June, 2004, respectively, and from Petitioner to Mr. Keenan) attached to the original petition set out Petitioner’s efforts and forwarded to Mr. Keenan a copy of the re-issue application (the ‘510 application) and an oath/declaration for that application; and

–two pieces of correspondence—one unsigned and undated but submitted with a copy of the envelope evidencing Mr. Keenan’s return address label and the other signed by Mr. Keenan and dated “9 June 04” both contain in one form or another the statement: “I . . . have no interest in signing anything”;

however, because there was no evidence in the record that Petitioner transmitted to Mr. Keenan a copy of the instant application (and an inquiry to Petitioner at the time this matter was taken up in the Office of Petitions on 17 March, 2004, as to whether he possessed documentation evidencing that a copy of the entire instant application—description, claims, abstract and drawing—was sent to Mr. Keenan and Petitioner’s response was that a copy of the instant application had not been sent), thus the original petition was dismissed on 18 March, 2005;

- the instant petition was filed on 11 April, 2005, and now is supported with documentation evidencing that the entire instant application was transmittal to Mr. Keenan and Petitioner avers that Mr. Keenan has not signed the oath/declaration.

This application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(a).

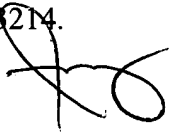
This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a).**

As provided under 37 C.F.R. §1.47(a), the Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition.

Notice of the filing of this application also will be published in the Official Gazette.

This file is being released to OIPE for processing as necessary to reflect the instant decision before being released for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be "J. Gillon", written over the printed name.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions



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COMMUNICATION

Dear Douglas M. Keenan:

You are named as inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. §116 (United States Code), and 37 C.F.R. §1.47,<sup>1</sup> ¶a, Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as inventor.

<sup>1</sup> The regulations at 37 C.F.R. §1.47 provide:

**§ 1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

© The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

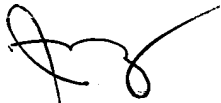
[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 C.F.R. §1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. §1.63.

Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733.

Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or toll-free: (800) 972-6382 (outside the Washington D.C. area).

Telephone inquiries concerning this letter may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
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Office of Petitions

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